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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,595	02/18/2004	Floyd Backes	160-054	3366
34845	7590	07/12/2005	EXAMINER	
STEUBING AND MCGUINNESS & MANARAS LLP			PHILPOTT, JUSTIN M	
125 NAGOG PARK			ART UNIT	
ACTON, MA 01720			PAPER NUMBER	
			2665	

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,595

Applicant(s)

BACKES ET AL.

Examiner

Justin M. Philpott

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20050527
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed April 25, 2005 have been fully considered but they are not persuasive. Specifically, applicant's arguments that the amended claims 1 and 6 are not taught by Karaoguz are not persuasive for the following three reasons.

1) First, contrary to applicant's assertion that Karaoguz does not teach evaluating parameters relating to the stations and causing station association, both within an access point, as newly recited in the amended claims 1 and 6, Karaoguz *does* in fact teach such limitations. Specifically, Karaoguz teaches "the access point can *process* the [parameter] information in a *location information processor* to *determine* the distance range of the customer's wireless device" (emphasis added) (paragraph 0033), wherein the distance range later causes particular station association. Thus, Karaoguz teaches the broad limitation of claims 1 and 6 of logic for evaluating the parameters wherein the evaluation is ultimately utilized to cause a station to become associated with an access point. Thus, applicant's argument is not persuasive.

2) Second, even if Karaoguz did not teach the above-mentioned processing, alternatively, applicant argues that the new limitations recited in the amended claims 1 and 6 are in fact provided by the central server in Karaoguz, but not by the access point in Karaoguz (e.g., page 6 of applicant's arguments filed April 25, 2005). With respect to this argument, it is generally considered to be within the ordinary skill in the art to shift the location of parts absent a showing of unexpected results. Thus, at the time of the invention it would have been obvious to one of ordinary skill in the art to shift the location of logic for evaluation and logic for causing

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association from a central server to an access point since it is generally considered to be within the ordinary skill in the art to shift the location of parts absent a showing of unexpected results. The contention of obvious choice in design can be overcome if Applicant establishes unexpected results. In re Japikse, 86 USPQ 70 (CCPA 1950). Thus, applicant's argument is not persuasive for this additional reason.

3) Third, even if Karaoguz did not teach the above-mentioned processing, *and* it were also not obvious to shift the location of the logic elements, applicant's argument fails to be persuasive for the additional reason that the body of claims 1 and 6 does not recite that the above-mentioned logic is in fact within an access point. Rather, the only reference to the elements being contained within an access point is made in the preamble of claims 1 and 6. Accordingly, in response to applicant's arguments, the recitation of "for use in an access point" (emphasis added) has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Still further, the mere recitation that the program product may be "for use in an access point" does not require its use to be within an access point. Thus, even if applicant is not persuaded that Karaoguz does in fact teach the newly added limitations of the amended claims 1 and 6 based upon the first reason discussed above, and alternatively, is not persuaded that the limitations are obvious in view of Karaoguz based upon the second reason discussed above, applicant's arguments on the whole are

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ultimately moot based upon the above-mentioned third reason since the limitations in the preamble are not given patentable weight and since the recitation does not even require the logic to be within an access point.

Accordingly, for the above-mentioned three reasons, applicant's arguments are not persuasive.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, claims 1 and 6 recite the limitation "the parameters" (claim 1, line 7; claim 6, line 11). There is insufficient antecedent basis for this limitation in the claim since previously the claims introduced the parameters as comprising as few as one parameter by reciting "one or more parameters" (claim 1, line 6; claim 6, line 6). Applicant may overcome this rejection by amending the claims to replace "the parameters" with "the one or more parameters".

Claims 2-5 are dependent upon claim 1 and are therefore rejected for the same reason as discussed above regarding claim 1.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific or substantial asserted utility or a well established utility.

Specifically, claims 1 and 6 recite "A program product for use in an access point", which indicates the program product may or may not be used in an access point. Without implementing the program product within a specific embodiment, the program alone does not comprise statutory subject matter. Applicant may overcome this rejection by amending claims 1 and 6 to instead recite "A program product in an access point".

Claims 2-5 depend upon claim 1 and are therefore also rejected for the same reason discussed above regarding claim 1.

7. Claims 1-6 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific or substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent

Application Publication No. US 2004/0054767 A1 by Karaoguz et al.

Regarding claim 1, Karaoguz teaches a program product for use in an access point (e.g., access point 115, see FIG. 1) in a wireless communications environment (e.g., wireless network 110) including multiple access points (e.g., see paragraphs 0019-0021 regarding a plurality of access points) and stations (e.g., wireless devices 120a-120n), wherein stations (e.g., 120a-120n) gain network access by associating with one or more of the access points (e.g., 115), the program product comprising a computer readable medium (e.g., inherently provided in access point 115 for “gather[ing] and stor[ing] statistical information” according to paragraph 0024 and also via location information processor described in paragraph 0033) having embodied therein a computer program for storing data (e.g., see paragraph 0024 regarding storing statistical information), the computer program comprising: logic for keeping track of one or more parameters related to stations in the network (e.g., gathering and storing statistical information such as location and identity information of the wireless devices 120-120n, power levels, channel cycling, frequencies, coverage area, traffic patterns, etc., see paragraph 0024); logic for evaluating the one or more parameters to produce an evaluation (e.g., see paragraph 0033 regarding location information processor determining the distance range using the gathered or stored information); and logic for causing a station (e.g., 120a-120n) to become associated with the access point (e.g., 115) based upon the evaluation (e.g., see paragraph 0045 regarding

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modifying the network to achieve optimized network configuration based upon the location information and statistical information; see also paragraph 0021 regarding a wireless devices receiving coverage from an access point in the geographic area upon the access point powering on, and paragraph 0028 regarding adjusting transmission power levels for optimal network configuration for continued coverage in accordance with the stored information; see also paragraph 0033 regarding location information processor for determining the distance range which is used for causing a station to become associated with an access point).

Regarding claim 2, Karaoguz teaches logic for receiving messages from stations, wherein the messages include at least some of the one or more parameters (e.g., see paragraphs 0029-0038 regarding determining device location, and specifically paragraph 0036 regarding the wireless device sending a range message acknowledgement).

Regarding claim 3, Karaoguz teaches a parameter is the number of stations associated with the access point (e.g., inherently represented by the identity information of each wireless device associated with the access point, see paragraph 0024).

Regarding claim 4, Karaoguz teaches a parameter is the distance of a station (e.g., wireless device 120a-120n) from the access point (e.g., 115) (e.g., see paragraphs 0029-0038, and specifically paragraph 0029 regarding determining a distance range location information of a wireless device).

Regarding claim 5, Karaoguz teaches at least some of the one or more parameters are stored in a table (e.g., see paragraph 0040 regarding the information being stored in a data memory unit within the access point, inherently comprising a table).

Regarding claim 6, as discussed above regarding claims 1-4, Karaoguz teaches a program product for use in an access point (e.g., access point 115, see FIG. 1) in a wireless communications environment (e.g., wireless network 110) including multiple access points (e.g., see paragraphs 0019-0021 regarding a plurality of access points) and stations (e.g., wireless devices 120a-120n), wherein stations (e.g., 120a-120n) gain network access by associating with one or more of the access points (e.g., 115), the program product comprising a computer readable medium (e.g., inherently provided in access point 115 for “gather[ing] and stor[ing] statistical information” according to paragraph 0024 and also via location information processor described in paragraph 0033) having embodied therein a computer program for storing data (e.g., see paragraph 0024 regarding storing statistical information), the computer program comprising: logic for keeping track of one or more parameters related to stations in the network (e.g., gathering and storing statistical information such as location and identity information of the wireless devices 120-120n, power levels, channel cycling, frequencies, coverage area, traffic patterns, etc., see paragraph 0024); logic for evaluating the one or more parameters to produce an evaluation (e.g., see paragraph 0033 regarding location information processor determining the distance range using the gathered or stored information); and logic for causing a station (e.g., 120a-120n) to become associated with the access point (e.g., 115) based upon the evaluation (e.g., see paragraph 0045 regarding modifying the network to achieve optimized network configuration based upon the location information and statistical information; see also paragraph 0021 regarding a wireless devices receiving coverage from an access point in the geographic area upon the access point powering on, and paragraph 0028 regarding adjusting transmission power levels for optimal network configuration for continued coverage in accordance with the stored

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information; see also paragraph 0033 regarding location information processor for determining the distance range which is used for causing a station to become associated with an access point). Further, as discussed above regarding claim 2, Karaoguz teaches logic for receiving messages from stations, wherein the messages include at least some of the one or more parameters (e.g., see paragraphs 0029-0038 regarding determining device location, and specifically paragraph 0036 regarding the wireless device sending a range message acknowledgement). Still further, as discussed above regarding claim 3, Karaoguz teaches a parameter is the number of stations associated with the access point (e.g., inherently represented by the identity information of each wireless device associated with the access point, see paragraph 0024). Finally, as discussed above regarding claim 4, Karaoguz teaches a parameter is the distance of a station (e.g., wireless device 120a-120n) from the access point (e.g., 115) (e.g., see paragraphs 0029-0038, and specifically paragraph 0029 regarding determining a distance range location information of a wireless device).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-6 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Karaoguz.

Regarding claims 1-6, Karaoguz teaches the program product discussed above regarding claims 1-6. Alternatively, if the processing in the access point (e.g., see paragraph 0033) in Karaoguz is interpreted not to be the *cause* of a station to become associated with an access point, but rather, as *assisting* the central server in causing a station to become associated with an access point, it is generally considered to be within the ordinary skill in the art to shift the location of parts absent a showing of unexpected results. In re Japikse, 86 USPQ 70 (CCPA 1950). Thus, at the time of the invention it would have been obvious to one of ordinary skill in the art to shift the location of logic for evaluation and/or logic for causing association from a central server to an access point since it is generally considered to be within the ordinary skill in the art to shift the location of parts absent a showing of unexpected results. The contention of obvious choice in design can be overcome if Applicant establishes unexpected results. In re Japikse, 86 USPQ 70 (CCPA 1950).

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

13. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

14. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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15. Claims 1-6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 10/781,458. Although the conflicting claims are not identical, they are not patentably distinct from each other because each recites logic performing identical functions.

16. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

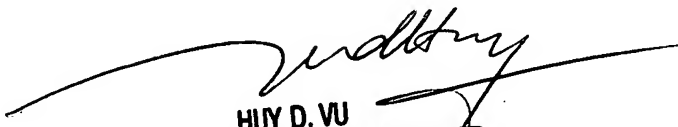
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin M. Philpott whose telephone number is 571.272.3162. The examiner can normally be reached on M-F, 9:00am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D. Vu can be reached on 571.272.3155. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Justin M Philpott


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